

## REMARKS

### INTRODUCTION

Claims 1-19 were previously and are currently pending and under consideration.

Claims 1, 4, 5, 8 and 11-19 are rejected.

No claims are amended herein.

Claims 2, 3, 6, 7, 9 and 10 are objected to.

No new matter is being presented, and approval and entry are respectfully requested.

### PREMATURE FINALITY

#### Not Same Invention

The reason give for the finality was that "all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application". However, the claims were not directed to the same invention. For example, the following text was added to claim 4:

[the information collection unit] responds to notices from information generation apparatuses with priorities higher than a preset priority by collecting stored generated information from such information generation apparatuses, and responds to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not collecting stored generated information from respective information generation apparatuses

This feature was not found in the previously claimed invention. Other substantive language was added to the claims. See also claims 1 and 14.

Although MPEP Chapter 7 does not provide a standard for determining a "same invention", in the context of § 101 double patenting, "'same invention' means identical subject matter" (emphasis added). Also, the Merriam Webster Online Dictionary defines "same" as (emphasis added):

1 a : resembling in every relevant respect b : conforming in every respect -- used with as

2 a : being one without addition, change, or discontinuance : IDENTICAL b : being the one under discussion or already referred to

3 : corresponding so closely as to be indistinguishable

It is respectfully submitted that the amended claims are not identical to the prior claims, they do not resemble or conform to them in every relevant respect, nor are they so similar to the prior claims as to be indistinguishable from them. This conclusion is affirmed by the fact that the Examiner provided significant new remarks and citations to address the amended claims. See items 2, 3, and 4 of the Office Action.

A first Office Action cannot be made final if the claims are directed to a different invention. This error alone is sufficient to withdraw the Finality of the Office Action mailed November 29, 2004. Withdrawal of the finality of the Office Action is respectfully requested.

#### Previous Ground of Rejection Not Sufficient to Reject Amended Claims

The finality is also traversed because the prior grounds of rejection were not sufficient to reject the amended claims.

In item 2 of the new Final Office Action, the Examiner states that "similar issues had been raised in Applicant's response to the previous non-final office action and had been properly responded by the examiner in the previous final office action" (page 8, top). The issue previously raised by the Applicant was that Krishnamurthy always collects a collection request; no collections are disregarded based on priority. That is to say, Applicant previously argued that Krishnamurthy acts on all collection requests and does not discard requests based on their priority.

In the previous Office Action (April 15, 2004), the Examiner responded by reasoning that "although Krishnamurthy's method does preserve all requests in a priority queue, it does not mean that all information would eventually be collected. This is because lower priority information may end up being discarded because of shortage in local storage space". (April 15, 2004 Office Action, item 13, emphasis added). Applicant amended claim 4 to recite (1) responding to notices from information generation apparatuses *with priorities higher than a*

*preset priority* by collecting stored generated information from such information generation apparatuses, and (2) responding to notices corresponding to information generation apparatuses *with priorities lower than the preset priority* by disregarding such notices by not collecting stored generated information from respective information generation apparatuses. In other words, some notices are disregarded based on priority.

The Examiner then issued the new Final Office Action in which the Examiner's reasoning shifted and a new ground of rejection was added. Specifically, the Examiner's new reasoning is that "by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected" (November 29, 2004 Office Action, item 2). *This reason for rejection was not previously presented.* In fact, this reasoning reflects a shift in the Examiner's use of Krishnamurthy to which Applicant has not been given an opportunity to respond.

Regardless of whether the Examiner is correct, this is not the same argument previously made by the Examiner. The Examiner previously reasoned that Krishnamurthy would not process come requests because of storage limitations. Respectfully, the record contradicts the Examiner's statement that the claims "could have been finally rejected on the grounds and art of record". Withdrawal of the Finality is respectfully requested.

#### Incomplete Rejection

Finally, the Finality of the Action is traversed because the rejection is incomplete. The rejection fails to address all features of the claims. The Examiner has not addressed the actual language and limitations of the claims. Amended claim 4 recites *responding to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not collecting stored generated information from respective information generation apparatuses*. Note that the preset priority cannot be so low that all notices have a priority above the preset priority.

Instead of explaining how Krishnamurthy meets this limitation, the Examiner reasoned that "by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data

would be collected" (November 29, 2004 Office Action, item 2). In other words, the Examiner is reasoning that the claims have a case where the threshold is such that all notices are collected. However, the limitation of claim 4 in the paragraph above does not allow such a low threshold. Claims 1 and 4 explicitly recited notice(s) with a priority *below* the threshold. The Examiner's reasoning that the claims have a case where all notices are collected clearly contradicts the explicit limitation that some notices are not collected.

Withdrawal of the Finality is respectfully requested because the Applicant has not been given an opportunity to respond to new grounds of rejection. As stated in MPEP 706.05:

The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application ... The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal.

Applicant has substantively amended the claims and has been prematurely been cut off in developing issues for appeal. Withdrawal of the Finality is respectfully requested.

### **REJECTIONS UNDER 35 USC § 103**

In the Office Action, at pages 2-5, claims 1, 4, 5 and 11-19 were rejected under 35 U.S.C. § 103 as being unpatentable over Krishnamurthy. This rejection is traversed and reconsideration is requested. At pages 5-6, claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over Krishnamurthy in view of Official Notice.

The rejection is traversed because the Examiner is constructing the claims in a manner contrary to the actual limitations of the claims. Amended claim 4 recites *responding to notices corresponding to information generation apparatuses with priorities lower than the preset priority by disregarding such notices by not collecting stored generated information from respective information generation apparatuses*. Note that the preset priority cannot be so low that all notices have a priority above the preset priority.

Instead of explaining how Krishnamurthy meets this limitation, the Examiner has

reasoned that "by setting the priority threshold to the lowest level, Applicant's collection system would produce equivalent result as that of Krishnamurthy, because potentially all the generated data would be collected" (November 29, 2004 Office Action, item 2, emphasis added). In other words, the Examiner is reasoning that the claims have a case where the preset priority (threshold) is so low that all notices are collected. However, the limitation of claim 4 in the paragraph above does not allow such a low threshold. In fact, claims 1 and 4 explicitly recite notice(s) with a priority *below* the threshold where these notices are explicitly not collected. The Examiner's reasoning that the claims read on or have a case where all notices are collected clearly contradicts the explicit limitation that some notices are not collected.

Furthermore, the Examiner states that "the priority value in Krishnamurthy's CTOC is originated in the end-point" (Office Action, item 3). Applicant does not disagree. However, the Examiner is not addressing the actual limitations of the claims. The claims do not concern the origin of a device's priority, rather the claims concern a priority of a device itself. Claim 1, for example, recites a priority definition table in which respective priorities of *said plurality of information generation apparatuses* are defined. The priorities are of the information generation apparatuses themselves. The priorities are not recited to be priorities of notices or collections per se. How or where Krishnamurthy sets a CTOC priority is irrelevant because the priority of a CTOC is "associated with the *collection data*", not the device from which it originated (column 7, line 18). Krishnamurthy explicitly describes the CTOC as "data structure including information about the collection such as source, recipient, priority, time window, and collection identifier". (column 5, lines 14-21, emphasis added). Although it is possible that the creator of the CTOC sets the priority of the CTOC, the priority is about the collection itself rather than the device that generated the collection.

Withdrawal of the rejection is respectfully requested.

## CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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### CERTIFICATE UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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STAAS & HALSEY

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Date: JAN 31, 2005